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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/758,873	01/10/2001	Shiping Chen	473532000100	9840

7590 02/08/2002
Charles D. Holland
Morrison & Foerster LLP
755 Page Mill Road
Palo Alto, CA 94304-0792

EXAMINER
GARCIA, MAURIE E

ART UNIT PAPER NUMBER

1627
DATE MAILED: 02/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/758,873

Applicant(s)

Chen et al

Examiner

Maurie E. Garcia, Ph. D.

Art Unit

1627



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ONE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-27 are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

Note: In an effort to enhance communication with our customers and reduce processing time, Group 1627 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-308-4315. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Jyothsna Venkat, Supervisory Patent Examiner, at (703) 308-2439. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-12, drawn to an apparatus for allowing specific identification of samples with probes, classified in various classes/subclasses, for example, class 435, subclasses 287.9 or 288.4 or class 436, subclasses 524-530.
 - II. Claims 13-15, drawn to a second apparatus for allowing specific identification of samples with probes, classified in various classes/subclasses, for example, class 435, subclasses 287.9 or 288.4 or class 436, subclasses 524-530.
 - III. Claims 16-19, drawn to a linear one-dimensional arrangement of probes, classified in various classes/subclasses depending on the probes, for example, class 435, subclasses 6, 7.1 or 91.1 or class 530, subclass 334.
 - IV. Claims 20-22, drawn to a probe-carrying tape apparatus, classified in various classes/subclasses depending on the identity of the "tape", for example, class 442, subclass 292 or any of class 535.
 - V. Claims 23-26, drawn to a probe-carrying fiber apparatus, classified in various classes/subclasses depending on the identity of the "fiber", for example, class 264, subclass 1.24.
 - VI. Claim 27, drawn to an apparatus for depositing a plurality of probes on a substrate, classified in various classes/subclasses, for example, class 422, subclass 100.

2. The inventions are distinct, each from the other because of the following reasons:
3. Groups I, II, IV, V and VI are different apparatuses. The apparatuses are different because they have different components and will produce different products and/or results. They therefore have different issues regarding patentability and enablement and represent patentably distinct subject matter. This is elaborated upon below.
4. In the instant case, the apparatuses of Groups I and II are different from the apparatuses of Groups IV and V because the apparatuses of Groups I and II specifically recite that they are "an apparatus for allowing specific identification of samples with probes", while the apparatuses of Groups IV and V specifically recite that they are a "probe-carrying tape apparatus" and "probe-carrying fiber apparatus", respectively. The apparatuses of Groups IV and V specifically recite that the substrate component is a "tape" or "fiber". This is not required by the apparatuses of Groups I and II.
5. The apparatuses of Groups I and II are different from each other because they require different components. The apparatus of Group I **only** requires a substrate and probes, while the apparatus of Group II additionally requires "a first layer".

6. The apparatuses of Groups IV and V are different from each other because they require different components. Each requires a different substrate. The apparatus of Group IV requires a "tape", while the apparatus of Group IV requires a "fiber".
7. The apparatus of Group VI is different from any of the apparatuses of Groups I, II, IV and V because the apparatus of Group VI deposits probes and uses capillaries. These components and result are not found in any of the other apparatuses.
8. Groups VI and III are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case, the product (linear one-dimensional arrangement of probes) could be made by a variety of apparatuses. For example, the arrangement of probes could be made with an apparatus that utilizes masking technology and synthesizes the probes directly on the substrate.
9. There does not appear to be a relationship between the product of Group III and the apparatuses of Groups I, II, IV and V. The inventions are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects. If applicant were to argue that the product of Group III (linear one-dimensional

arrangement of probes) could be made or used in the apparatuses of Groups I, II, IV or V, the same rationale as in paragraphs 8 and 10 applies.

10. The two apparatuses of Groups VI and V (probe-carrying tape apparatus and probe-carrying fiber apparatus) can also be interpreted as products (i.e. the probe-carrying tape and probe-carrying fiber themselves). As such, they are related to Groups I and II as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case each of Group VI and V could be used in different processes/apparatuses. For example, the tape or fiber could be used as a substrate to create further probe libraries (by making modifications to the probes thereon).

11. These inventions have acquired a separate status in the art as shown by their different classification and/or divergent subject matter. Please note that even though some of these groups could be classified in the same class/subclass, this has no effect on the non-patent literature search. Each of the different inventions would require completely different searches in the patent and non-patent databases, and there is no expectation that the searches would be coextensive. Art anticipating one Group would not anticipate the other Groups and each Group could support a separate patent.

Therefore, this does create an undue search burden, and restriction for examination purposes as indicated is proper.

12. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143). Because the above restriction/election requirement is complex, a telephone call to applicants to request an oral election was not made. See MPEP § 812.01.

13. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

14. Applicant is also reminded that a 1 - month (not less than 30 days) shortened statutory period will be set for response when a written requirement is made without an action on the merits. This period may be extended under the provisions of 37 CFR 1.136(a). Such action will not be an "action on the merits" for purposes of the second action final program, see MPEP 809.02(a).

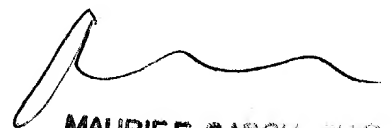
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15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurie E. Garcia, Ph.D. whose telephone number is (703) 308-0065. The examiner can normally be reached on Monday-Thursday from 9:00 to 6:30 and on alternate Fridays.

16. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothsna Venkat, can be reached on (703) 308-2439. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Maurie E. Garcia, Ph.D.
February 7, 2002



MAURIE E. GARCIA, Ph.D.
PATENT EXAMINER



RESTRICTION ELECTION FACSIMILE TRANSMISSION

DATE:

FROM/ATTORNEY:

FIRM:

PAGES, INCLUDING COVERSHEET:

PHONE NUMBER:

TO EXAMINER: Maurie E. Garcia, Ph.D.

ART UNIT: 1627

SERIAL NUMBER:

FAX/TELECOPIER NUMBER: (703) 308-4315

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FOR RESPONSES TO RESTRICTIONS.**

COMMENTS: _____

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